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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/681,724
Filing Date: October 08, 2003
Appellant(s): KUMMER ET AL.

MAILED

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Brian A. Lemm
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 26, 2007 appealing from the Office action mailed May 1, 2007.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

Patents:

5,842,186	Kulik	11-1998
5,831,220	Ramsden, et al.	11-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulik, U. S. Pat. No. 5,842,186 (Reference AC of the IDS submitted on 10/08/2003) in view of Ramsden, et al., U.S. Pat. No. 5,831,220 (Reference A of the PTO-892 part of Paper No. 20061101).

As per claim 11, Kulik teaches a mail processing system for processing a mail piece comprising: a postage meter for applying postage values to said mail piece (column 5, line 15); a scale for weighing said mail piece (column 5, line 14); a central processing unit controlling operation of said postage meter and said scale (column 5, line 19-20); and a memory storing postage rating information (column 5, lines 21, 34-35) and software executable by said central processing unit (column 5, line 20), said software including instructions for performing: receiving a first class of service from a user for processing said mail piece (column 4, lines 58-59); determining a weight of said

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mail piece using said scale (column 4, lines 60-61); determining whether said first class of service received from said user is appropriate for said mail piece using said determined weight and other parameter (column 8, lines 38-41), and if said first class of service is not appropriate, determining a second class of service for said mail piece using said determined weight and other parameter (column 8, lines 41-44), said second class of service being appropriate for said mail piece (column 8, lines 41-44); setting a final class of service for said mail piece (column 8, line 40), said final class of service being said first class of service if said first class of service is determined to be appropriate and said second class of service if said first class of service is determined to not be appropriate (column 8, lines 38-44; column 7, lines 16-25); and determining a postage amount for said mail piece using said determined weight, at least one dimension, said final class of service and said postage rating information (column 5, lines 3-6; column 7, lines 50-53).

Kulik does not teach a dimensioning module for determining at least one dimension of said mail piece, does not teach the central processing unit controlling said dimensioning module, and does not teach determining at least one dimension of said mail piece using said dimensioning module. Ramsden, et al. teaches a dimensioning module for determining at least one dimension of said mail piece (column 16, lines 1-3), the central processing unit controlling said dimensioning module (column 17, lines 20-21); determining at least one dimension of said mail piece using said dimensioning module (column 16, line 31). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate a dimensioning module for determining at least one dimension of said mail piece, the central processing unit controlling said dimensioning module; determining at least one dimension of said mail piece using said dimensioning module; into the system taught by Kulik because dimensions are used to determine postage charges (as taught by Ramsden, et al., column 2, lines 49-52).

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As per claim 12, Kulik in view of Ramsden, et al. teaches the system of claim 11 as described above. Kulik further teaches the software further includes instructions for causing said postage meter to apply said determined postage amount to said mail piece or a tape to be applied to said mail piece (column 5, lines 28-33).

As per claim 13, Kulik in view of Ramsden, et al. teaches the system of claim 11 as described above. Ramsden, et al. further teaches receiving one or more special services to be applied to said mail piece (column 2, lines 54-55). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate receiving one or more special services to be applied to said mail piece into the system taught by Kulik in view of Ramsden, et al. because many deliverers offer special services for a premium price (as taught by Ramsden, et al., column 1, lines 31-32).

As per claim 14, Kulik in view of Ramsden, et al. teaches the system of claim 13 as described above. Ramsden further teaches determining whether each of said special services is applicable to said mail piece using said postage rating information, said postage rating information including special service availability information, and generating a list of applicable special services for said mail piece (column 2, lines 49-53). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate determining whether each of said special services is applicable to said mail piece using said postage rating information, said postage rating information including special service availability information, and generating a list of applicable special services for said mail piece into the system taught by Kulik in view of Ramsden, et al. because many deliverers offer special services for a premium price (as taught by Ramsden, et al., column 1, lines 31-32).

As per claim 15, Kulik in view of Ramsden, et al. teaches the system of claim 14 as described above. Kulik further teaches determining a postage amount for said mail

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piece using said determined weight, said determined at least one dimension, and said final class of service (column 5, lines 1-8). Kulik does not teach determining a postage amount for said mail piece using said list of applicable special services. Ramsden, et al. teaches determining a postage amount for said mail piece using said list of applicable special services (column 2, lines 52-53). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate determining a postage amount for said mail piece using said list of applicable special services into the system taught by Kulik in view of Ramsden, et al. because many deliverers offer special services for a premium price (as taught by Ramsden, et al., column 1, lines 31-32).

As per claim 16, Kulik in view of Ramsden, et al. teaches the system of claim 14 as described above. Ramsden, et al. further teaches determining whether each of said special services is applicable to said mail piece is based on said final class of service, said determined weight, said determined at least one dimension, and a determination as to whether all applicable prerequisite requirements have been satisfied (column 21, lines 6-14). Examiner is interpreting determining if a service option is "available" as determining whether all applicable prerequisite requirements have been satisfied. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate determining whether each of said special services is applicable to said mail piece is based on said final class of service, said determined weight, said determined at least one dimension, and a determination as to whether all applicable prerequisite requirements have been satisfied into the system taught by Kulik in view of Ramsden, et al. because many deliverers offer special services for a premium price (as taught by Ramsden, et al., column 1, lines 31-32).

As per claim 17, Kulik in view of Ramsden, et al. teaches the system of claim 14 as described above. Ramsden, et al. further teaches the software further includes instructions for storing transaction information for said mail piece in said memory

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(column 10, lines 8-9). The limitation "said transaction information including said determined postage amount and said final class of service" is a recitation of the non-functional descriptive material (i.e., transaction information) stored on the memory and is afforded no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the software further includes instructions for storing transaction information for said mail piece in said memory into the system taught by Kulik in view of Ramsden, et al. in order to maintain a package history log (as taught by Ramsden, et al., column 10, line 42).

As per claim 18, Kulik in view of Ramsden, et al. teaches the system of claim 11 as described above. Ramsden, et al. further teaches the software further includes instructions for storing transaction information for said mail piece in said memory (column 10, lines 8-9). The limitation "said transaction information including said determined postage amount, said final class of service and said list of applicable special services" is a recitation of the non-functional descriptive material (i.e., transaction information) stored on the memory and is afforded no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the software further includes instructions for storing transaction information for said mail piece in said memory into the system taught by Kulik in view of Ramsden, et al. in order to maintain a package history log (as taught by Ramsden, et al., column 10, line 42).

As per claim 19, Kulik in view of Ramsden, et al. teaches the system of claim 11 as described above. Kulik further teaches determining whether said first class of service supports said determined at least one parameter (column 8, lines 38-39; Tables

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1-3) and, if not, finding a third class of service that supports said determined at least one parameter (column 8, lines 41-43; Tables 1-3); determining whether one of said first class of service and said third class of service, if applicable, supports said determined weight (column 8, lines 38-43; Tables 1-3) and, if not, finding a fourth class of service that support said determined weight (column 8, lines 45-46; Tables 1-3); setting said second class of service equal to said third class of service if said first class of service does not support said at least one parameter and said third class of service supports said weight (column 7, lines 21-23; column 8, lines 41-43; Tables 1-3); and setting said second class of service equal to said fourth class of service if neither of said first class of service and said third class of service, if applicable, support said determined weight (column 7, lines 21-23; column 8, lines 45-46; Tables 1-3); wherein said first class of service is appropriate if said first class of service supports said determined weight (column 7, lines 18-21; column 8, lines 38-39; Tables 1-3). Kulik further teaches that a dimension is a parameter, along with weight, that is used to determine appropriate classes of mail (column 5, lines 1-4).

As per claim 20, Kulik in view of Ramsden, et al. teaches the system of claim 19 as described above. Kulik further teaches determining said third class of service and said fourth class of service based on predetermined rules for switching classes (column 6, lines 44-45; Tables 1-3). Examiner is interpreting a rates manager with break points for each selected class as predetermined rules for switching classes.

(10) Response to Argument

A. Introduction.

Appellant argues that the disclosure of the Kulik reference is not sufficient to present, in combination with the Ramsden reference, a prima facie case of obviousness under § 103(a). This argument is supported by assertions that Kulik does not teach certain aspects of the claimed invention; however examiner respectfully submits that this is not the case. Appellant's argument rests on both an embodiment of the invention

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that is narrower in scope than the one positively recited in the disputed claims, as well as on a mischaracterization of Kulik's disclosure.

B. Appellant argues an embodiment narrower in scope than the limitations positively recited in the claims.

The claim limitation principally at issue is found in the independent claim 11: "receiving a first class of service from a user for processing said mail piece" (lines 10-11). In arguing the alleged deficiencies of Kulik to meet this limitation, appellant repeatedly uses verbiage that does not appear and is narrower than that which is actually used in the claims. For example, appellant argues: "[I]n Kulik, the operator does not select a class of service for processing the mail pieces, but instead selects a rate table." Appeal Brief, page 6. The activities of the operator, which are the focus of appellant's argument, are not part of the claim. Rather, it is the mere receipt of information at the memory that is claimed. The words "select" or "selection" appear nowhere in the claims themselves. To meet this limitation, the prior art need only disclose the receipt of a class of service, and that this class of service is characterized in that it is in some manner "from a user." Kulik meets this limitation as provided in the previous Office action and further discussed below.

As another example, appellant argues that even if "it is assumed that the operator in Kulik can select as class, the system in Kulik will still not operate in the same manner as the present invention . . . [because processing] is still based solely on the weight of the mail piece as provided for in the custom rate table, and not on the preferred class." Appeal Brief, page 7. Neither the word "preferred" nor an indication of any preference whatsoever for one particular class over another does appears in the disputed claims, so it is unclear and confusing as to why appellant would require Kulik's system to base mail classification on a "preferred class" to meet the limitations of the claim.

The invention as claimed does not exclude any intervening acts to that receipt of a class of service, nor does it limit the receipt to a certain time such as just before

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processing of each mail piece. Moreover, the disputed claims are all directed toward an apparatus rather than a process, and therefore must distinguish over the prior art structurally rather than manipulatively. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Thus, any intervening function (such as creating a custom rate table template) or temporal differentiation (i.e., the custom rate table is selected prior to mail processing but subsequent to the class selections) between the receipt of a class of service and mail processing in the claimed invention and in Kulik is immaterial for the purposes of determining patentability over the prior art under § 103(a).

C. Appellant mischaracterizes the disclosure of Kulik.

Appellant presents, at best, an incomplete portrayal of the teachings that Kulik would impart to one of ordinary skill in the art. For example, appellant quotes two sentences from column 4 of Kulik and asserts that the cited passage "clearly indicates that the operator in Kulik selects a rate table, and not a class." Appeal Brief, page 6. As already noted, it is unclear as to why appellant would require the operator in Kulik to select a class, since operator class selection appears nowhere in the claims themselves. Even so, a fair reading of Kulik is not so limited. When applying § 103(a), the prior art references must be considered as a whole. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). To that end, in addition to the passage cited by appellant, Kulik also discloses the following regarding the system's user interface:

The mail processor prompts the user for input of class selection and corresponding parameter values. The mail processor determines the validity of the class selections and corresponding parameter values based on the standard postage rate information. The mail processor stores class selections and corresponding parameter values only if found valid.

Kulik, column 3, lines 57-63 (emphasis added).

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Continuing that argument appellant states that Kulik's system "automatically applies the class specified for the weight of the mail piece without regard to a class selected by a user" Appeal Brief, page 8. On the contrary, the user's input on classes is required for Kulik's custom rate tables to be functional, and the appropriateness of the classes are determined for each mail piece. "[T]he custom rates processor 31 interrogates the rates manager 25 to obtain break point and postage values for each selected class and range specified in the custom template." Kulik, column 6, lines 43-46 (emphasis added). "[T]he mail processor applies standardized postage rates from different mail classes to pieces of mail with a single stream" Kulik, column 7, lines 24-26 (emphasis added). Kulik allows for greater functionality than the claimed invention by allowing for customized rate tables to be selected for processing based upon classes of service chosen by the user that created the template; but the conclusion does not follow that the disclosure is therefore deficient to teach the broadly claimed "receiving a first class of service from a user."

D. The teachings of Kulik are sufficient to teach the plain meaning disputed limitations in light of the specification.

"During examination, claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Academy of Sciences*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004) (citations omitted). One having ordinary skill in the art would not interpret the limitations of the disputed claims so narrowly, as appellant argues, so that they could be considered patentable over the explicit teachings of Kulik taken as a whole in view of Ramsden.

By processing mail using Kulik's custom rate tables the system necessarily processes mail using a memory storing classes of service received from a user, because without receipt classes from a user the custom rate table would not exist. The system determines the proper class among a group of classes received from a user for

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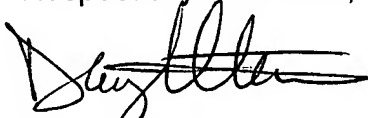
the mail piece's parameters in Kulik, as is set forth in the claims. Accordingly, because the scope of the claims is broader than asserted by appellant, the disclosure of Kulik is more extensive than asserted by appellant, and when both are properly construed Kulik meets the disputed claim limitations, examiner respectfully maintains that the above rejections are proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

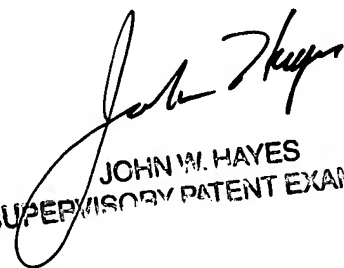


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